

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY GOLDSHER and
TOM FRANCIS SOBOLESKI

Appeal No. 2000-0450
Application 09/047,048

ON BRIEF

Before CALVERT, FRANKFORT and MCQUADE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10, 12, 13, 15 to 17, 20 and 21. Of the other claims remaining in the application, claims 1 to 9 and 11 stand withdrawn from consideration under 37 CFR § 1.142(b) as being directed to a

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nonelected invention, and claims 14, 18 and 19 are indicated as being allowable, subject to being rewritten in independent form.

The claims on appeal are drawn to an animal waterer assembly (claims 10, 12, 13, 15 to 17 and 20) and a method for adjusting the height of an animal waterer (claim 21). They are reproduced in the appendix of appellants' brief.

The references applied in the final rejection are:

Matthysse	2,616,646	Nov. 4,
1952		
Vik	4,348,989	Sep. 14, 1982

The appealed claims stand finally rejected on the following grounds:

- (1) Claims 10, 12, 13, 15, 17 and 20, anticipated by Matthysse, under 35 U.S.C. § 102(b);
- (2) Claim 16, unpatentable over Matthysse, under 35 U.S.C. § 103(a);
- (3) Claim 21, anticipated by Vik, under 35 U.S.C. § 102(b).

Rejection (1)

On pages 3 and 4 of the final rejection, supplemented by pages 4 and 5 of the examiner's answer, the examiner sets

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forth the basis for his conclusion that claims 10, 12, 13, 15, 17 and 20 are anticipated by Matthyse. Appellants argue, in essence, that there is no anticipation because independent claims 10 and 12 are directed to an animal waterer, not a high voltage bus line, and recite a locking portion intended to allow vertical movement or adjustment of the pipe, not removal of the clamp from the pipe (brief, page 4). Also, in their reply brief (pages 2 to 4) appellants contend that Matthyse does not disclose a pipe for carrying water, a locking portion that allows vertical movement of the pipe, or a bracket for attaching the assembly to a structure.

It is fundamental that in order to anticipate a claim, "a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). However, a reference need not "teach" what the application teaches in order to anticipate the claims, as long as the claims "read on" something disclosed in the reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

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Also, recitation of a new intended use for an old product does not make a claim to that old product patentable. Schreiber, supra.

First considering claim 10, the preamble of this claim recites "[a]n animal waterer assembly comprising." We do not consider that weight should be given to this language, because it does not recite structural limitations of the claimed invention, but only recites the purpose or intended use, with a structurally complete invention being defined in the body of the claim. See Pitney Bowes Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999), citing Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951); also see In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). The recitation of an animal waterer assembly therefore does not patentably distinguish claim 10 from the bus-support clamp disclosed by Matthysse.

The fact that the pipe claimed in claim 10 is recited as being "for supplying water from a water source to an animal" does not preclude reading the claimed pipe on the tubing 18 of Matthysse, since the language "for supplying . . . animal" is only a statement of intended use which does not distinguish

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over the prior art, rather than a structural limitation. Cf. In re Collier, 397 F.2d 1003, 1006, 158 USPQ 266, 268 (CCPA 1968) and In re Gregg, 244 F.2d 316, 317, 113 USPQ 526, 529 (CCPA 1957) ("it is well settled that claims drawn to structure cannot be allowed unless they recite some structural difference over the prior art"). As for the claimed bracket, Matthyse discloses the bracket 15 attached to supporting structure 12.

Finally, with regard to appellants' argument that the Matthyse bracket does not allow vertical adjustment of the pipe,

claim 10 recites "in said locked position said locking portion . . . securing said pipe in a vertical position, in said unlocked position said locking portion allowing vertical movement of said pipe." Giving this language its broadest reasonable interpretation, and not reading limitations thereinto from the specification, In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1058 (Fed. Cir. 1993), we consider it to be readable on Matthyse. The bracket 10 of Matthyse secures pipe 18 in a vertical position in the sense that the

pipe cannot move vertically when the bracket is locked,¹ and when the bracket is unlocked, thus no longer supporting the pipe, the pipe would clearly be allowed to move vertically.

Consequently, since all of the structure recited in claim 10 may be read on Matthyse, the rejection of claim 10 under § 102(b) will be sustained.

We will also sustain the rejection of claim 12, and of claims 13, 15, 17 and 20, which appellants have grouped with claim 12 (brief, page 3). 37 CFR § 1.192(c)(7). Most of the foregoing discussion of the rejection of claim 10 is applicable to claim 12; the only limitation of claim 12 which appellants argue separately from claim 10 is the limitation that in the unlocked position the locking portion "releas[es] said pipe from said set position for adjustment of said pipe." This limitation does not distinguish claim 12 from Matthyse, however, because, assuming arguendo that "for adjustment of said pipe" should be given patentable weight, once Matthyse's clamp is unlocked and released from pipe 18, the pipe is free for "adjustment," as broadly recited. Claim 12 is therefore

¹ The claims do not require the central axis of the pipe to be vertical.

readable on Matthyse.

Rejection (2)

As to this rejection, appellants argue, inter alia, that Matthyse constitutes nonanalogous art. We agree with this argument, and therefore will not sustain rejection (2).²

Under the two-part test for analogous art enunciated in In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992), prior art is analogous (1) if it is from the applicant's field of endeavor, or (2) if not, if it "still is reasonably pertinent to the particular problem with which the [applicant] is involved." The Matthyse patent does not meet either prong of

this test. First, it clearly is not from appellants' field of endeavor. Second, appellants are concerned with the problem of adjusting the height of a vertically oriented animal watering pipe, while Matthyse is concerned with clamping an insulator to a high voltage bus line, a problem which we do

² We note that, as pointed out by the examiner in the final rejection (page 6), the question of nonanalogous art is relevant to the issue of obviousness, but not to anticipation. In re Schreiber, 128 F.3d at 1478, 44 USPQ2d at 1432.

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not regard as reasonably pertinent to appellants'. Thus, since neither of the criteria set forth in Clay is satisfied, Matthyse is nonanalogous art.

Rejection (3)

Appellants do not argue the merits of this rejection in their brief. Rather, they assert on page 5 of the brief that the amendment after final rejection (filed June 28, 1999) overcomes the rejection, and request that this Board enter the amendment in spite of the examiner's refusal to do so.

The refusal of an examiner to enter an amendment after final rejection is a matter which this Board has no jurisdiction to consider, but rather should be raised by a petition to the Commissioner under 37 CFR § 1.181. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967); see Manual of Patent Examining Procedure § 1002.02(c), item 3(b) (July 1998). Accordingly, appellants' argument cannot be considered by us.

No other arguments having been presented, rejection (3) will be sustained.

Conclusion

The examiner's decision to reject claims 10, 12, 13, 15

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to 17, 20 and 21 is reversed as to claim 16, and is affirmed
as to the other claims.

No time period for taking any subsequent action in
connection with this appeal may be extended under
37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN P. MCQUADE)	
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